

### **REMARKS**

These remarks are responsive to the non-final Office Action of January 26, 2005. Claims 1-20 are pending. No new matter has been added. A terminal disclaimer is provided herewith. Applicant respectfully requests reconsideration and allowance of the instant application.

#### **Double Patenting**

Claims 1-20 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of USSN 10/184,000, filed January 28, 2002 and/or USSN 10/382,652, filed March 7, 2003.

Despite the apparent differences between the claims, Applicants have filed herewith a Terminal Disclaimer rendering these rejections moot. Accordingly, applicants request these rejections be withdrawn.

#### **Claim Rejections – 35 U.S.C. §102 (b)**

In the Office Action, claims 13-15 were rejected under 35 U.S.C. § 102(b) as anticipated by Naoyuki (JP 2000-200147). Independent claim 13 recites an electronic input device configured for scrolling of an image relative to a display screen in first and second perpendicular scrolling directions. The device includes a housing; a scroll wheel being rotatable relative to the housing about an axis to cause scrolling of the image in the first direction, and the scroll wheel being pivotally displaceable relative to the housing to cause scrolling of the image in the second direction perpendicular to the first direction.

With regard to Naoyuki, element 212, shown in Figures 5(A)-5(C), is a stick. (See paragraphs 011-0012 of translation). Element 212 is clearly not a scroll wheel. Further element 212 does not rotate. In Figures 4(A)-4(C) of Naoyuki, element 202 (apparently the Office Action mentions as a scroll wheel) does not pivot. Therefore, the embodiment of element 202 has no teaching of image scrolling with pivoting movement. Notably, Naoyuki fails to disclose the recited features of a scroll wheel being pivotally displaceable relative to the housing to cause scrolling of the image in the second direction perpendicular to the first direction. Naoyuki fails to disclose each and every feature of claim 13. Hence, claim 13 is allowable over Naoyuki. Dependent claims 14 and 15 are allowable for at least the reasons of claim 13 and for further features recited therein.

**Claim Rejections – 35 U.S.C. §103 (a)**

**Claim 1**

In the Office Action, claims 1-8 were rejected under 35 U.S.C. § 103(a) under a combination of Pruchniak (U.S. Pat. No. 6,075,518) and Naoyuki (JP 2000-200147). Claim 1 recites, among other features, an input device for scrolling an image relative to an image display screen along perpendicular axes. A scroll wheel assembly including a rotatable member which is positioned within an opening of the input device housing. The rotatable member is rotatable about a first axis extending within the housing and the rotatable member is pivotally movable about a second axis within the opening. The first axis and the second axis are perpendicular to each other. A movement sensing system is configured for sensing rotational movement of the rotatable member about the first axis, and the movement sensing system is configured to sense pressure applied to the rotatable member for the pivotal movement.

Pruchniak fails to disclose the recited input device. For example, there is no movement sensing system configured for sensing rotational movement of the rotatable member about the first axis, and configured to sense pressure applied to the rotatable member for the pivotal movement.

There is no motivation to combine Pruchniak and Naoyuki. Further, the combination of Pruchniak and Naoyuki fails to reach the device of claim 1. In the Office Action, the alleged motivation is “[i]t would have been obvious to have modified Pruchniak with the teachings of Naoyuki, since they both teach *scrolling wheel input device having rotation and pivoting functions...*”(Office Action, pg. 5)(emphasis provided). Contrary to the Office Action with regard to Naoyuki, element 212, shown in Figures 5(A)-5(C), is a stick. (See paragraphs 011-0012 of translation). Element 212 is clearly not a scroll wheel, nor does it rotate as recited in claim 1. In Figures 4(A)-4(C) of Naoyuki, element 202 does not pivot as alleged in the Office Action. Contrary to the alleged motivation in the Office Action, there is no scrolling wheel input device having rotation and pivoting functions for scrolling an image relative to an image display screen along perpendicular axes with the recited movement sensing system.

In Pruchniak, the movement of control arm (40) to microswitches 34 merely results in a *selection*. (See col. 4, ll. 58-65). Notably, there is no image scrolling associated with this movement. The teachings of Pruchniak and Naoyuki with respect to the scroll wheel movement and image scrolling operations are simply lacking. There is no movement sensing system configured for sensing rotational movement of the rotatable member about the first axis, and configured to sense pressure applied to the rotatable member for the pivotal movement for the recited scrolling of an image as recited in claim 1. When evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when they are missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because the examiner ignored a claimed limitation that was absent from the reference). In view of the foregoing reasons, claim 1 is allowable over Pruchniak and Naoyuki. Further, claims 2-8 are for at least the reasons of claim 1 and are allowable for the features recited therein.

#### **Claim 9**

In the Office Action, claims 9-12 and 17-20 were rejected under 35 U.S.C. § 103(a) under a combination of Pruchniak and Naoyuki. Independent claim 9 recites, among other features, a method of scrolling an image relative to a display screen using an input device having a housing and a member that is rotatable and pivotal relative to the housing. The method includes steps of receiving input for pivotally moving the rotatable member relative to a plane in which the member is rotatable; sensing relative changes in lateral pressure applied to the member; and controlling a rate of scrolling of an image on the display screen responsive the step of sensing.

In Pruchniak, the movement of control arm (40) to microswitches 34 merely results in a *selection*. (See col. 4, ll. 58-65). Notably, Pruchniak microswitches 34 do not sense relative changes in lateral pressure. Further, there is no image scrolling associated with this movement. Contrary to the Office Action, Naoyuki merely has so-called finger "scroll buttons 602" shown in Figures 9(A)-9(C) and the arrows "C" point downward.

There is no teaching of sensing changes in lateral pressure as recited in claim 9. Further, in the embodiment of Figures 4(A)-4(C) of Naoyuki, element 202 does not pivot.

Therefore, the embodiment of element 202 has no teaching of image scrolling and sensing changes pressure with pivoting movement. In view of the foregoing, both Pruchniak and Naoyuki fail to teach a step of *sensing relative changes in lateral pressure applied to a rotatable member*. When evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when they are missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, claim 9 is allowable for at least the foregoing reasons.

Furthermore, there is no motivation to combine Pruchniak and Naoyuki in the manner proposed. As noted above, Pruchniak's control arm merely results in a selection, but no teaching of image scrolling. In Naoyuki, scroll buttons 602 are neither associated with the recited pivotable movement, nor movement of a rotatable member. In particular, in the embodiment of Figures 4(A)-4(C) of Naoyuki, element 202 does not pivot. It is respectfully submitted that the Office Action relies on teachings of Pruchniak and Naoyuki that are clearly divergent. Motivation to combine the references is lacking. The legal standard of obviousness requires that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the matter claimed." *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (emphasis added). Hence, the Office has failed to state a supported case of *prima facie* obviousness. Accordingly, claim 9 is allowable for at least the foregoing reasons. Claims 10-12 depending, directly or indirectly, from independent claim 9 are allowable for all the reasons given above, and further in view of the additional features recited therein.

#### **Claim 17**

Claim 17 recites, among other features, a scroll wheel assembly including a rotatable member that is laterally movable relative to said housing, and a sensor positioned within said housing for sensing lateral movement of the rotatable member; the

sensor including at least one linear extendable member which is engageable with the rotatable member so as to provide a rate of change of said lateral movement.

Both Pruchniak and Naoyuki fail to reach invention of claim 17. For example, Naoyuki fails to teach (1) a rotatable member which is laterally moveable; (2) a sensor

for sensing lateral movement of the rotatable member; and (3) the sensor including at least one linear extendable member which is engageable with the rotatable member so as to provide a rate of change of the lateral movement. In Pruchniak, there is no sensor which senses lateral movement in which the sensor includes at least one linear extendable member that is engageable with the rotatable member so as to provide a rate of change of said lateral movement. When evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when they are missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, claim 17 is allowable for at least the foregoing reasons.

Claims 18-20 depending, directly or indirectly, from independent claim 17 are allowable for all the reasons given above, and further in view of the additional features recited therein. For example, with regard to claim 18, Pruchniak fails to disclose a rotatable member that is laterally movable along a shaft extending within the opening.

#### **Claim 9**

In the Office Action, claims 9-11 and 17-18 were rejected under 35 U.S.C. § 103(a) under a combination of Pruchniak and U.S. Pat. No. 6,198,473 to Armstrong. Applicants disagree with the rejections. Both Pruchniak and Armstrong fail to reach invention of claim 9. In Pruchniak, the movement of control arm (40) to microswitches 34 merely results in a *selection*. (See col. 4, ll. 58-65). Notably, Pruchniak microswitches 34 do not sense relative changes in lateral pressure. Further, there is no scrolling associated with this movement. Armstrong does not have a rotatable member, but merely has scroll buttons for engaging with a finger. There is no teaching of sensing changes in lateral pressure with a rotatable member as recited in claim 9. Additionally, the alleged motivation in the Office Action is unsupported. The legal standard of obviousness requires that “particular findings must be made as to the reason the skilled artisan, with

no knowledge of the claimed invention, would have selected these components for combination in the matter claimed.” *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (emphasis added). Hence, the Office has failed to state a supported case of *prima facie* obviousness. Accordingly, claim 9 is allowable for at least the foregoing reasons. Claims

10-12 depending, directly or indirectly, from independent claim 9 are allowable for all the reasons given above, and further in view of the additional features recited therein.

### Claim 17

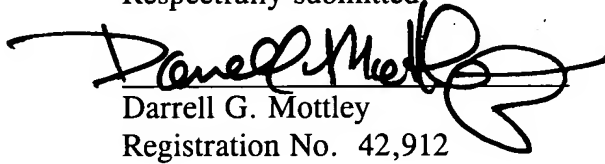
Both Pruchniak and Armstrong fail to reach invention of claim 17. For example, Armstrong fails to teach (1) a rotatable member which is laterally moveable; (2) a sensor for sensing lateral movement of the rotatable member; and (3) the sensor including at least one linear extendable member which is engageable with the rotatable member so as to provide a rate of change of the lateral movement. In Pruchniak, there is no sensor which senses lateral movement in which the sensor includes at least one linear extendable member that is engageable with the rotatable member so as to provide a rate of change of the lateral movement. When evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when they are missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). It is respectfully submitted that there is no motivation to combine the references. Further, the alleged motivation is unsupported. In view of the foregoing, claim 17 is allowable for at least the foregoing reasons.

Claims 18-20 depending, directly or indirectly, from independent claim 17 are allowable for all the reasons given above, and further in view of the additional features recited therein. For example, with regard to claim 18, Pruchniak fails to disclose a rotatable member that is laterally movable along a shaft extending within the opening.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in better form for allowance, the Examiner is respectfully urged to contact Applicant's undersigned representative at the below-listed number. If any additional fees are required or if an overpayment has been made, the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Respectfully submitted,

  
Darrell G. Mottley  
Registration No. 42,912

Date:

April 26 2005

BANNER & WITCOFF, LTD.  
1001 G Street, N.W., 11<sup>th</sup> Floor  
Washington, D.C. 20001-4597  
(202) 824-3000